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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DAVID EDWARD CALDWELL, MICHAEL WHITE,
and TANYA KORELSKY

_____

Appeal 2008-0623
Application 09/761,604[1]
Technology Center 2100

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Decided: April 11, 2008

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Before LANCE LEONARD BARRY, JAY P. LUCAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1, 3, 5 to 11, 13,

and 14 under authority of 35 U.S.C. § 134. The Board of Patent Appeals

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[1] Application filed January 16, 2001. The real party in interest is CoGenTex,
Inc.

and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). An Oral

Hearing was held at the U.S. Patent and Trademark Office on April 8, 2008.

Appellants' invention relates to a method for automatically generating

natural language text to give users recommendations of which products (e.g.,

a digital camera) are best suited to the user's individual needs. In the words

of the Appellants:

> The Natural Language Product Comparison Guide
> Synthesizer of the invention (henceforth, "the Synthesizer") is a
> software tool that lets developers easily create web-based
> comparison guides for a given type of product. Each
> comparison guide will solicit users' product requirements, let
> them compare different products, and recommend one or
> more products based on their preferences. The guide will use
> automatically generated natural language to facilitate the
> comparison of products, and to convey and explain its
> recommendations.

(Specification, Page 2.)

Claim 1 is exemplary:

> 1. A method of creating an automated natural language product
> recommendation system for providing customers with a personalized
> recommendation of a product having a plurality of features, each customer
> being associated with a user profile comprising a collection of values of
> features that are considered to be suitable for a user of the product,
> comprising the steps of:

> i. developing feature text snippets for each feature, the snippets
> being phrases to be used when describing or referring to
> particular product features;

     ii.   developing user profile text snippets for each user profile, the snippets being phrases to be used when describing or referring to particular user profiles;

     iii.   providing generic phrases such that combining the generic phrases with feature text snippets and user profile text snippets produces a personalized recommendation for the product featuring dynamically generated fluent text that is used to convey a product analysis and recommendation tailored to the user requirements and preferences.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| Tavor | US 2001/0032077 A1 | Oct. 18, 2001 |
| Mikurak | US 2004/0064351 A1 | Apr. 1, 2004 |

Rejection:

Claims 1, 3, 5 to 11, 13, and 14 stand rejected under 35 U.S.C. § 103(a) for being obvious over Tavor in view of Mikurak.

Appellants contend that the claimed subject matter is not rendered obvious by Tavor in combination with Mikurak, for failure of the references to teach the claimed subject matter. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not

to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).[2]

    We reverse.

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ISSUE
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    The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references Tavor and Mikurak teach the step of "developing user profile text snippets for each user profile" as claimed.

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FINDINGS OF FACT
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    The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method of synthesizing written text in an idiomatic natural language to help prospective buyers by providing information about products, for example, on the Internet (Specification 3:1-5). The synthesizer assembles its text from snippets, which are specifically defined in the specification (Specification 8, lines 20 *et seq.*). In addition to snippets that describe and compare the products (Specification 9, lines 5 *et seq.*), snippets are generated related to various user profiles, with respect to the products (Specification 10, bottom). For

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[2] Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991).

example, the prospective purchaser of a camera may **"want to take vacation snapshots, without having to be a rocket scientist,"** which is a snippet to which some purchasers can relate. Additionally, generic snippets are also prepared to "fill in" the text around the substantive snippets in order to produce explanatory text (Specification 11, bottom half).

2. The Tavor Patent Application Publication describes a system for assembling natural language text to aid a purchaser by describing the products he is considering, perhaps for acquisition over the Internet (Abstract). The text may be comparative of a few products or descriptive of features and suitability of a particular product (¶ [0047]). The text is assembled from relevant value words fit into templates (e.g., ¶¶ [0025], [0026]) including generic phrases, for example "the wine is rather sweet," to aid in natural sounding text (¶[0027]).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejection of Appellants' claims under 35 U.S.C. § 103. The prima facie case is presented on pages 3 to 5 of the Examiner's Answer.

In opposition, Appellants present a number of arguments. The first argument contends that Tavor does not "develop user profile text snippets for each user profile" as claimed (Brief 8, bottom). In reviewing the Tavor reference we find that although Tavor has extensive disclosure of feature snippets (i.e. value words, as describe in ¶¶0024, 0025) concerning the products (*see* FF2 above), there are no text snippets that relate to a user profile. The Examiner argues that simply because the presented snippets respond to a user request, the response is effectively customized to that user's preferences (Answer 5, middle). While appreciating this point of view, we are not convinced that this presents sufficient structure to render the claims obvious. The user profile text snippets are described in the claim as comprising a collection of values of features considered suitable for a user of the product fitting the profile. This is more customized than simply one who asks about that product (e.g., camera) as people of different profiles may be asking about that camera.

We also note that the generic phrases combine in the claim with the feature text snippets and the user profile snippets to produce a personalized recommendation, functionally engaging the snippets in the formulation of the recommendation.

The Examiner also relies on Mikurak to supply the teaching of fluent text tailored to the user requirements (Answer 3, bottom). We have reviewed

all the Examiner's citations in Mikurak, and also the general thrust of the Mikurak reference (*Id.*), and we do not find in that description of an automated manufacturing system and method the teachings of the claimed user profile text snippets.

In summary, we agree with Appellants that the Examiner has not supported the rejection of the noted claims with a teaching from the cited prior art. As this argument affects all the appealed claims, the further arguments by Appellants concerning specific claims (e.g., Brief 18 and 19) need not be addressed.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1, 3, 5 to 11, 13, and 14 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1, 3, 5 to 11, 13, and 14 is reversed.

<u>REVERSED</u>

clj

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